



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,634	03/02/2004	Yasunori Azuma	450100-04961	3082

7590 02/27/2007
FROMMER LAWRENCE & HAUG LLP
745 Fifth Avenue
New York, NY 10151

EXAMINER

SAVLA, ARPAN P

ART UNIT PAPER NUMBER

2185

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/791,634

Applicant(s)

AZUMA, YASUNORI

Examiner

Arpan P. Savla

Art Unit

2185

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 1/19/07.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 19, 2007 has been entered.

Response to Amendment

This Office action is in response to Applicant's communication filed January 19, 2007 in response to the Office action dated October 23, 2006. Claims 1-3 and 5-7 are pending in this application.

ACKNOWLEDGMENT OF REFERENCES CITED BY APPLICANT

Information Disclosure Statement

1. As required by MPEP § 609(c), Applicant's submission of the Information Disclosure Statement dated January 19, 2007 is acknowledged by the Examiner and cited references have been considered in the examination of the claims now pending. As required by MPEP § 609 c(2), a copy of the PTOL-1449 initialed and dated by the Examiner is attached to the instant Office action.

REJECTIONS NOT BASED ON PRIOR ART

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 1-3 and 5-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

4. **As per claim 1**, the claim positively recites that “the drives are assigned respective node IDs as first addresses and respective port IDs that represent mounted order numbers as second addresses.” However, the newly added negative limitation recites a situation in which “each of the drives are not assigned the first address and the second address.” The negative limitation directly contradicts the earlier positive recitation that the drives are assigned the first and second addresses and therefore renders the scope of the claim indefinite.

5. **As per claim 5**, the claim positively recites “assigning respective node IDs as first addresses and respective port IDs that represent mounted order numbers as second addresses to a plurality of drives.” However, the newly added negative limitation recites a situation in which “each of the drives are not assigned the first address and the second address.” The negative limitation directly contradicts the earlier positive recitation of assigning respective first and second addresses to a plurality of drives and therefore renders the scope of the claim indefinite.

REJECTIONS BASED ON PRIOR ART

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 1-3 and 5-7 are rejected under 35 U.S.C. 103(a) as being obvious over Goodman et al. (U.S. Patent 6,757,694) in view of Allen et al. (U.S. Patent Application Publication 2002/0161852) and in further view of Golasky et al. (U.S. Patent 6,880,101).**

8. **As per claim 1**, Goodman discloses a tape library apparatus (col. 2, lines 5-7; Fig. 1) to which a node ID is assigned (col. 2, lines 46-48; Figs. 1 and 5, element 47) and that is connected to a host computer (col. 2, line 33; Fig. 3, element 28), comprising:

a plurality of drives for recording and reproducing data to and from respective large capacity tape recording mediums, the drives having respective interfaces being capable of transferring large capacity data to the host computer (col. 2, lines 7-10, 25-28, and 32-35; Fig. 1, elements 12 and 14; Fig. 3, elements 28 and 29). *It should be noted that "reading/read from" is analogous to "reproducing", "data storage media" is analogous "tape recording mediums", and "host system" is analogous to "host computer."*

the drives are assigned respective port IDs that represent mounted order numbers as second addresses (col. 3, lines 43-44; col. 4, lines 38-39) and the interfaces are activated (col. 2, 25-28 and 32-35; Fig. 3, element 29). *It should be noted that "drive position" is analogous to "mounted order number." It should also be noted that it is inherently required the interface be activated in order for the host system to read and write data to and from the tape drives.*

Goodman does not expressly disclose the drives are assigned respective node IDs as first addresses;

and wherein an address previously assigned to the drive upon production is used when (i) each of the drives are not assigned the first address and the second address and (ii) a command causing the drive to be assigned the first address and the second address is not received from the host computer.

Allen discloses the drives are assigned respective node IDs as first addresses and respective port IDs as second addresses (paragraph 0047, lines 7-8; Fig. 2, elements 255, 260, and 265). *It should be noted that "node_name" is analogous to "node ID" and "port_name" is analogous to "port ID."*

Goodman and Allen are analogous art because they are from the same field of endeavor, that being Fibre Channel systems.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to implement Allen's World Wide Name (WWN), which contains both a node ID and port ID, within Goodman's WWN, which is dependent on drive position.

The motivation for doing so would have been to gain the benefit of uniquely identifying and tracking devices connected to a Fibre Channel network through a SCSI bridge (Allen, paragraph 0027).

The combination of Goodman/Allen does not expressly disclose wherein an address previously assigned to the drive upon production is used when (i) each of the drives are not assigned the first address and the second address and (ii) a command causing the drive to be assigned the first address and the second address is not received from the host computer.

Golasky discloses an address previously assigned to the drive upon production is used when (i) each of the drives are not assigned the first address and the second address and (ii) a command causing the drive to be assigned the first address and the second address is not received from the host computer (col. 5, lines 28-33). *It should be noted that "WWN" is analogous to "address that has been assigned to the drive upon production."*

The combination of Goodman/Allen and Golasky are analogous art because they are from the same field of endeavor, that being Fibre Channel systems.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to implement Golasky's WWN within Goodman/Allen's Fibre Channel system.

The motivation for doing so would have been to assign Fibre Channel devices with unique global IDs that identify the device's vendor and serial number, thus

providing SAN management which includes compartmentalization, authorization, and securitization.

Therefore, it would have been obvious to combine Goodman, Allen, and Golasky for the benefit of obtaining the invention as specified in claim 1.

9. **As per claim 2**, the combination of Goodman/Allen/Golasky discloses when a new drive is mounted on the tape drive apparatus, the newly mounted drive is assigned the first address and the second address in accordance with a command received from the host computer (Goodman, col. 4, lines 39-42; col. 2, lines 28-32). *It should be noted that WWN assigned to the new drive is taken to be the combination of Goodman's WWN and Allen's WWN as established in the 35 USC 103 rejection of claim 1 above.*

10. **As per claim 3**, the combination of Goodman/Allen/Golasky discloses when the mounted position of each of the drives is changed, the moved drive is assigned the first address and the second address in accordance with a command received from the host computer (Goodman, col. 4, line 60 – col. 5, line 6; col. 2, lines 28-32). *It should be noted that when a drive is moved its position in the library will change. However, since the WWN is based in part on drive position, the moved drive will be assigned a new WWN.*

11. **As per claim 5**, Goodman discloses a method of controlling a tape library apparatus to which a node ID is assigned (col. 2, lines 46-48; Figs. 1 and 5, element 47) and that is connected to a host computer (col. 2, line 33; Fig. 3, element 28), comprising the steps of:

assigning respective port IDs that represent mounted order numbers as second addresses to a plurality of drives (col. 3, lines 43-44; col. 4, lines 38-39) for recording and reproducing data to and from respective large capacity tape recording mediums (col. 2, lines 7-10, 25-28, and 32-35; Fig. 1, elements 12 and 14; Fig. 3, elements 28 and 29), the drives having respective interfaces being capable of transferring large capacity data to the host computer (col. 2, 25-28; Fig. 3, element 29),

and activating the interfaces (col. 2, 25-28 and 32-35; Fig. 3, element 29).

Please see citation notes for claim 1 above.

Goodman does not expressly disclose assigning respective node IDs as first addresses to a plurality of drives;

and using an address previously assigned to the drive up production when each of the drives are not assigned the first address and the second address and a command causing the drive to be assigned the first address and the second address is not received from the host computer.

Allen discloses assigning respective node IDs as first addresses and respective port IDs as second addresses to a plurality of drives (paragraph 0047, lines 7-8; Fig. 2, elements 255, 260, and 265). *Please see the citation notes for claim 1 above.*

At the time of the invention it would have been obvious to a person of ordinary skill in the art to implement Allen's World Wide Name (WWN), which contains both a node ID and port ID, within Goodman's WWN, which is dependent on drive position.

The motivation for doing so would have been to gain the benefit of uniquely identifying and tracking devices connected to a Fibre Channel network through a SCSI bridge (Allen, paragraph 0027).

The combination of Goodman/Allen does not expressly disclose using an address previously assigned to the drive up production when each of the drives are not assigned the first address and the second address and a command causing the drive to be assigned the first address and the second address is not received from the host computer.

Golasky discloses using an address previously assigned to the drive up production when each of the drives are not assigned the first address and the second address and a command causing the drive to be assigned the first address and the second address is not received from the host computer (col. 5, lines 28-33). *Please see the citation note for claim 1 above.*

The combination of Goodman/Allen and Golasky are analogous art because they are from the same field of endeavor, that being Fibre Channel systems.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to implement Golasky's WWN within Goodman/Allen's Fibre Channel system.

The motivation for doing so would have been to assign Fibre Channel devices with unique global IDs that identify the device's vendor and serial number, thus providing SAN management which includes compartmentalization, authorization, and securitization.

Therefore, it would have been obvious to combine Goodman, Allen, and Golasky for the benefit of obtaining the invention as specified in claim 5.

12. **As per claim 6**, the combination of Goodman/Allen/Golasky discloses when a new drive is mounted on the tape drive apparatus, assigning the newly mounted drive the first address and the second address in accordance with a command received from the host computer (Goodman, col. 4, lines 39-42; col. 2, lines 28-32). *Please see the citation note for claim 2 above.*

13. **As per claim 7**, the combination of Goodman/Allen/Golasky discloses when the mounted position of each of the drives is changed, assigning the moved drive the first address and the second address in accordance with a command received from the host computer (Goodman, col. 4, line 60 – col. 5, line 6; col. 2, lines 28-32). *Please see the citation note for claim 3 above.*

Response to Arguments

14. Applicant's arguments filed January 19, 2007 with respect to **claims 1-3 and 5-7** have been fully considered but they are not persuasive.

15. With respect to Applicant's argument in the first full paragraph of section II on page 6 of the communication filed January 19, 2007 which states, "The two alternative recitations which state, "...the drives are assigned..." and "...the drives are not assigned" are just stating different scenarios for address assignment to the drives upon "a command causing the drive to be assigned the first address and the second address is

Art Unit: 2185

not received from the host computer", as stated in claim 1" the Examiner respectfully disagrees. The Examiner asserts that the claim is not just stating different scenarios, but rather positively reciting one scenario in the second limitation and then later reciting a negative limitation in the third limitation that clearly contradicts the positive recitation. By stating that "...the drives are assigned respective node IDs as first addresses and respective port IDs that represent mounted order numbers as second addresses..." claim 1 is saying that no matter what, under any and all circumstances, 100% of the time, the drives are indeed assigned respective node IDs as first addresses and respective port IDs that represent mounted order numbers as second addresses. Thus, there cannot be a different scenario for address assignment (i.e. there cannot be a different scenario when the drives are not assigned the first address and the second address). Unlike conditional recitations (in which different scenarios are in fact possible), the second limitation of claim 1 is the essence of a positive recitation. Accordingly, since the third limitation recites a negative limitation that clearly contradicts the positive recitation of the second limitation, the Examiner maintains the rejection of claim 1 under 35 U.S.C. 112, second paragraph as being indefinite.

16. With respect to Applicant's argument in the second full paragraph of section II on page 6 of the communication filed January 19, 2007, the Examiner respectfully disagrees under the same rationale as used to reject claim 1.

17. With respect to Applicant's argument beginning on the fourth full paragraph on page 8 of the communication filed January 19, 2007 which states, "Further, Golasky does not suggest the drive replacement without shutting down or re-booting of the library system" the Examiner respectfully notes that the features upon which Applicant relies (i.e., drive replacement without shutting down or re-booting of the library system) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

18. With respect to Applicant's argument in the second full paragraph on page 9 of the communication filed January 19, 2007 which states, "Specifically, Applicant submits that there is no teaching or suggestion of tape library apparatus to which a node ID is assigned and that is connected to a host computer wherein an address previously assigned to the drive upon production is used when (i) each of the drives are not assigned the first address and the second address and (ii) a command causing the drive to be assigned the first address and the second address is not received from the host computer" the Examiner respectfully disagrees and directs Applicant to both the prior art rejection as well as the 35 U.S.C. 112, second paragraph rejection of claim 1 above.

19. With respect to Applicant's argument in the third full paragraph on page 9 of the communication filed January 19, 2007 which states, "Indeed, Applicant submits that when a host address may be a fibre channel world wide name (WWN), which is an eight

Art Unit: 2185

byte unique identifier, and the Institute of Electronics Engineers (IEEE) assigns blocks of WWNs to manufacturers so manufacturers can build fiber channel devices with unique WWNs is completely different than an address previously assigned to the drive upon production is used when (i) each of the drives are not assigned the first address and the second address and (ii) a command causing the drive to be assigned the first address and the second address is not received from the host computer" the Examiner respectfully disagrees. Firstly, the Examiner asserts that Golasky's unique WWN assigned by the IEEE to the manufacturer upon building of the fibre channel device is indeed equivalent to an address previously assigned to the drive upon production. Secondly, the Examiner notes that the limitation in question above is a negative limitation. Accordingly, the Examiner asserts that Golasky discloses each of the drives are assigned the first address and the second address and a command causing the drive to be assigned the first address and the second address is received from the host computer. Consequently, Golasky sufficiently discloses an address previously assigned to the drive upon production ("WNN") is used when each of the drives are not assigned the first address and the second address (which is always the case in Golasky) and a command causing the drive to be assigned the first address and the second address is not received from the host computer (which, again, is always the case in Golasky).

20. With respect to Applicant's argument in the first full paragraph on page 10 of the communication filed January 19, 2007, the Examiner respectfully disagrees under the same rationale as used to reject claim 1.

21. With respect to Applicant's argument in the second full paragraph on page 10 of the communication filed January 19, 2007, the arguments rely on the allegation that independent claims 1 and 5 are allowable and therefore for the same reasons the dependent claims are allowable. However, as addressed above, independent claims 1 and 5 are not allowable, thus, Applicant's arguments with respect to the dependent claims are not persuasive.

Conclusion

STATUS OF CLAIMS IN THE APPLICATION

The following is a summary of the treatment and status of all claims in the application as recommended by MPEP 707.70(i):

CLAIMS REJECTED IN THE APPLICATION

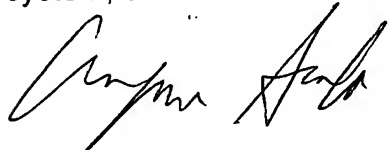
Per the instant office action, **claims 1-3 and 5-7** have received a first action on the merits and are subject of a first action non-final.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arpan P. Savla whose telephone number is (571) 272-1077. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sanjiv Shah can be reached on (571) 272-4098. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2185

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Arpan Savla
Art Unit 2185
February 17, 2007



SANJIV SHAH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100